

REMARKS

By this amendment, claims 1, 6, 8, 10-17, and 19-26 have been amended. These amendments are made to even more clearly recite the claimed invention, do not add prohibited new matter and are fully supported by the specification. Support for the amendments to the claims may be found, for example, on page 24, lines 18-24, of the specification. Reconsideration and withdrawal of the rejections set forth in the outstanding Office Action are respectfully requested in view of the following remarks.

Rejections under 35 U.S.C. § 103(a)

The Office Action rejects claims 1-10, 13, 14, 17, and 18-20, and 23, and 24 (inadvertently indicated as claims 1-10, 13, 14, 17, and 18 on page 3 of the detailed portion of the Office Action) under 35 U.S.C. § 103(a) as being unpatentable over WAESTERLID (WO 01/65807) and EIDEN et al. (U.S. Pat. App. Pub. No. 2002/0168992), in view of KAWAGUCHI et al. (U.S. Pat. App. Pub. No. 2002/0037736), and further in view of MIZUTANI et al. (U.S. Patent Application Publication No. 2001/0022780). The Office Action also rejects claims 11, 12, 15, 16, 21, 22, 25, and 26 (inadvertently indicated as claims 11, 12, 15, and 16 on page 53 of the detailed portion of the Office Action) under § 103(a) as being unpatentable over WAESTERLID in view of KAWAGUCHI et al., and in further view of MIZUTANI. Applicants respectfully traverse the grounds of the rejection.

Initially, Applicants note that the newly cited reference, MIZUTANI, is directed to a communication method that performs an on-demand type of group communication among a plurality of communication terminals. Paragraph [0012] of MIZUTANI teaches:

a terminal that communicates sends a packet with [sic] appending the information about a valid time period of the group, as well as its own identification information, then a terminal that received the packet storing the identification information and the information about the valid time period that are included in the packet, and a communication terminal performing the group communication transferring a packet based on the stored identification information and the information about the valid time period. This identification information is, for example, an originator ID appended to the header of the packet. (see also paragraphs [0013], [0045], [0046] and Figure 3 of MIZUTANI).

Due to the suggestion of a time period in MIZUTANI, the Office Action concludes that MIZUTANI teaches that the time the group is formed is included in the correspondence, as recited in the claims (see page 10 of the Office Action). However, Applicants submit that the time period in MIZUTANI is only used to determine when the group will be terminated (see paragraph [0045] of MIZUTANI). The time period is not included in the group identification information, as recited in Applicants' claims. The time period is simply included in the same packet that includes the group identification information. For this reason alone, Applicants submit that MIZUTANI fails to disclose or render obvious that "the group identification information comprises user identification information of the terminal device of a member who forms the group and *a time when said group is formed*," as recited in Applicants' claims. Therefore, Applicants submit that, even if one attempted to combine the teachings of the various references in the manner suggested by the Examiner, one would fail to arrive at the claimed invention, as such as combination would fail to disclose or render obvious all of the elements of Applicants' claimed invention.

Furthermore, Applicants note that the claims also recite "wherein the group identification information is a unique identifier for each group, and the group identification information can be generated at the terminal device of the member who forms the group." In contrast, MIZUTANI teaches that:

[s]ince a communication terminal that has ceased from communication due to its movement can not send a new packet, the life time of the group ends and this communication terminal withdraws from the group. When this communication terminal wants to resume communication, it is possible to generate a new group that belongs to the same party. (see paragraph [0045] of MIZUTANI).

Based on this section of MIZUTANI and because the group identification information is not generated based on the time that the group is formed, non-unique group identifiers are generated for groups with the same party. Therefore, the claim recitation “the group identification information is a unique identifier for each group” is neither disclosed or rendered obvious by MIZUTANI, contrary to the Examiner’s arguments. Thus, Applicants submit that the cited publications (alone or in any proper combination) fail to disclose or render obvious all of the elements of Applicants’ claimed invention.

Applicants also note that the claims recite “wherein the unique identifier for each group is generated based on the time the group is formed.” For the reasons discussed above, Applicants submit that MIZUTANI further fails to disclose or render obvious this element of the claimed invention.

As WAESTERLID, EIDEN, and KAWAGUCHI fail to cure the aforementioned deficiencies of MITZUTANI, Applicants submit that the cited publication (either alone or in any proper combination) fail to disclose, suggest, or render obvious all of the elements of Applicants’ claimed invention.

Furthermore, Applicants submit that it would be improper to assume that simply because MIZUTANI discloses a “valid time period” (or expiration date or time) for a communication group that one skilled in the art would use this “valid time period” to form or generate unique group identification information in the manner recited in the claims. Such an assumption would

be without any reasoning without some rational underpinning to support a determination of obviousness.

Under MPEP § 2143.01, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Indeed, the Supreme Court has refined the standards for obviousness in *KSR International v. Teleflex*. However, the Court has not abandoned the requirement for any motivation or suggestion in the art to combine the teachings of two publications. Rather, the recent *KSR* decision supports combining teachings of publications in cases where “there is [a] design need or market pressure to solve a problem, and there are finite number of identified, predictable solutions.” *KSR International v. Teleflex*, 127 S. Ct. 1727, 1742 (2007).

In this instance, there is not a finite number of identified, predictable solutions because there are a myriad of ways to approach the problem of identifying a group in this technology field. Thus, Applicants submit that there is insufficient motivation to combine the cited publications in the manner suggested by the Examiner. Furthermore, even assuming *arguendo*, that certain individual elements of the claimed invention are known in the art, there is no reason or suggestion that would guide one skilled in the art to arrive at the claimed combination.

Accordingly, in view of the above arguments and remarks, Applicants respectfully request reconsideration of the 35 U.S.C. § 103 rejections asserted against Applicants’ claims that are pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Lastly, the dependent claims are submitted to recite further patentable subject matter of the invention and, therefore, are also submitted to be allowable over the prior art of record. As such,

allowance of the dependent claims is deemed proper for at least the same reasons noted above for the independent claims, in addition to reasons related to their own recitations. Accordingly, Applicants respectfully request reconsideration of the outstanding rejections and an indication of the allowability of all of the claims in the present application.

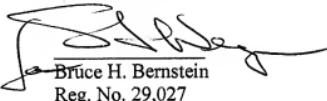
CONCLUSION

In view of the foregoing, it is submitted that the Examiner's rejections should be withdrawn. Entry and consideration of the present amendment, reconsideration of the outstanding Office Action, and allowance of the present application and all of the claims therein are respectfully requested are now believed to be appropriate.

Applicants note that this amendment is being made to advance prosecution of the application to allowance, and should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejections is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

If the Examiner has any questions or comments regarding this response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
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